

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1-3, 5, 6, 12 and 15 are currently pending in this application. None of the claims have been amended. Accordingly, no new matter has been added.

In view of the remarks herein, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

Specification Issues

The Examiner objects to the specification "because it introduces new matter into the disclosure." Applicants respectfully traverse.

In the Response filed on August 17, 2009, the Specification was amended to identify previously presented "Examples 1-8" as comparative or "Referential Examples 1-8." The Examiner has taken the position that the above amendment to the Specification introduces new matter.

Applicants respectfully submit that the amendment to the Specification does not introduce new matter. Specifically, the disclosure objected to by the Examiner has not been recently introduced into the Specification, but is rather a part of the originally filed Specification. The only change incorporated therein was the identification of some of the former Examples as "Referential Examples," as they now fall outside of the scope of the invention as claimed. Thus, no new matter has been introduced into the Specification.

In view of the above, reconsideration and withdrawal of this objection are respectfully requested.

Issues Under 35 U.S.C. 103(a)

Claims 1-3 and 5-6 stand rejected under 35 U.S.C. 103(a) as being obvious over Jenkins et al. (U.S. 5,637,143) (hereinafter Jenkins '143) in view of Schmid et al. (U.S. 5,364,467) (hereinafter Schmid '467) in further view of Mei et al. (U.S. 6,894,089) (hereinafter Mei '089). Additionally, claims 12 and 15 stand rejected as being obvious over Jenkins '143 in view of Schmid '467, Mei '089 and Shimizu et al. (U.S. 4,842,837) (hereinafter Shimizu '837). Applicants respectfully traverse.

The Examiner asserts that Jenkins '143 teaches an anti-corrosive aluminum pigment of high metallic luster, treated with phosphomolybdic acid. The Examiner acknowledges that Jenkins '143 fails to teach or suggest that the pigment is coated with silica, or that the pigment is further coated with a coating prepared from a silane composition. The Examiner relies on the teachings of Schmid '467 and Mei '089 to overcome these deficiencies.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). "[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ 2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion,

motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

As previously discussed, none of the cited references (e.g., Jenkins '143, Schmid '467 and Mei '089) teach or suggest the simultaneous use of three coatings on the aluminum pigment (i.e., molybdenum, silica and silane coupling agent) as presently claimed (see, e.g., claim 1). Moreover, Applicants have provided evidence to show that superior and unexpected results are obtained when combining three coatings (i.e., molybdenum, silica and a silane coupling agent), as compared to the case where only one coating or two coatings is/are applied.

The Examiner has taken the position that the Declaration under 37 CFR 1.132 filed on August 17, 2009 is insufficient to overcome the rejection of the claims, and argues that "...while the claims recite a range, the evidence submitted provides for a single point only within that range." Applicants respectfully disagree.

Initially, Applicants note that pending claim 1 does not require a specific range for molybdenum and/or silicon oxide. One of the novel features of the present invention is the combined use of a molybdenum coat, a silica coat and a coat prepared from a silane coupling agent. As such, Applicants submit that the previously filed Declaration is commensurate in scope with the claims and provides sufficient evidence of the superior and unexpected results obtained by using the claimed three coatings.

The Declaration compares Example 10 of the present application (corresponding to claim 1) with Jenkins '143 (Comparative Example 3), Schmid '467 (Referential Examples 1-3 and 5-8)

and Mei '089 (Referential Example 4), and evidences the superior effects exhibited by the present invention over the cited references, from which is derived a conclusion that it would not have been obvious to combine Jenkins '143, Schmid '467 and Mei '089. The Examiner is respectfully reminded that, under U.S. patent laws, evidence of unobvious or unexpected advantageous properties, such as superiority in a property the claimed compound shares with the prior art, can rebut a *prima facie* case of obviousness. Courts have ruled that "[e]vidence that a compound is unexpectedly superior in one of a spectrum of common properties . . . can be enough to rebut a prima facie case of obviousness." No set number of examples of superiority is required. See *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987); see also MPEP 716.02(a).

Moreover, if the invention claimed in claim 1 was obvious over the teachings of Jenkins '143, Schmid '467 and Mei '089, those skilled in the art would have already combined these references so as to obtain the superior effects of the present invention. The fact that no one has ever combined the teachings of these references before evidences the non-obviousness of the claimed invention over these references.

In view of the above, reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a


full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Vanessa Perez-Ramos, Reg. No. 61,158 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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